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Filing date: **01/25/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214649
Party	Defendant Benny Hodge
Correspondence Address	BENNY HODGE 122 COUNTRY CLUB DR GREENWOOD, MS 38930 6802 UNITED STATES bennyhodge25@yahoo.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Benny Hodge
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Signature	/Benny Hodge/
Date	01/25/2015
Attachments	MOTION TO SUSPEND PROCEEDING FOR CIVIL ACTION.pdf(322334 bytes ) civil action.pdf(219704 bytes ) civil action 1.pdf(248614 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mark: BENNY HUNNA

Serial No: 85/920,599

Filing Date: May 01, 2013

NOODLE TIME, INC. vs. BENNY HODGE

Opposition No. 91214649

**MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL  
ACTION PURSUANT TO TRADEMARK RULE 2.117(a)**

Applicant, Benny Hodge hereby moves for suspension of these proceedings pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.2117(a).

On December 22, 2014 BENIHANA NATIONAL CORP., sister company of NOODLE TIME INC, filed a complaint in United States District Court for the Northern District of Mississippi against Applicant, Benny Hodge, for trademark infringement and dilution among other claims. In support of this motion, Applicant submits herewith a copy of the filed complaint by BENIHANA NATIONAL CORP.

The pending civil action involves issues which are involved in the proceeding, namely whether BENIHANA NATIONAL CORP. has been harmed by Applicants filing of intent to use application Serial No: 85/920,599 , Subject Mark BENNY HUNNA, and whether any trademark rights owned by BENIHANA NATIONAL CORP. have been infringed upon. The determination of these issues by the District Court will likely be dispositive of the issues involved in this proceeding

Applicant, Benny Hodge therefore respectfully requests suspension of these proceeding pending determination of the civil action pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a).

DATE: JANUARY 25,2015

**X** Benny Hodge

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Benny Hodge  
Defendant

Benny Hodge

122 Country Club Dr.

Greenwood, Ms 38930

Tel: (662)897-8525

E-mail: [bennyhodge25@yahoo.com](mailto:bennyhodge25@yahoo.com)

### **CERTIFICATE OF SERVICE**

**I HEREBY CERTIFY** that the foregoing MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION PURSUANT TO TRADEMARK RULE 2.117(a) has been served on Opposers in the following manner:

**By E-Mail**

Janet C. Moreira

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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF MISSISSIPPI  
GREENVILLE DIVISION

BENIHANA NATIONAL CORP., a Delaware  
corporation,  
*Plaintiff,*

vs.

BENNY HODGE, an individual, d/b/a  
BENNY HUNNA  
*Defendant.*

4:14cv178-SA-JMV

**COMPLAINT**

**JURY TRIAL DEMANDED**

Plaintiff, Benihana National Corp. ("BNC"), a Delaware corporation, by and through its undersigned counsel, files this complaint against Defendant Benny Hodge d/b/a Benny Hunna ("Defendant") and in support of its claims alleges as follows:

**INTRODUCTION**

The BENIHANA® trademark has been extremely successful and famous since the first restaurant was introduced in New York in 1964. Since then, BNC<sup>1</sup> has opened, itself and/or through franchisees, more than 64 teppanyaki restaurants throughout the United States, Caribbean, Central America, and South America. Over the course of the last 50 years, the BENIHANA® mark has garnered international fame and recognition and the distinctive and federally registered BENIHANA® mark has become synonymous with dining and entertainment.

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<sup>1</sup> Benihana, Inc. is the parent company of Benihana National Corp. and Noodle Time, Inc. Noodle Time, Inc. is the owner of the BENIHANA® Trademarks and Benihana National Corp. is the exclusive licensee of the BENIHANA® Trademarks with the right to license and franchise the BENIHANA® Trademarks and with rights of enforcement.

### **THE PARTIES**

1. Plaintiff Benihana National Corp. ("Plaintiff" or "BNC") is a Delaware corporation with a principal place of business of 8750 NW 36<sup>th</sup> Street, Suite 300, Doral, Florida 33178.

2. Defendant Benny Hodge d/b/a BENNY HUNNA is, upon information and belief, a musical entertainer in Greenville, Mississippi. Defendant promotes his entertainment services, live performances, and musical recordings and videos online via You Tube and Facebook, among other websites. Defendant uses the confusingly similar and dilutive name BENNY HUNNA in connection with his advertising and promotion of such goods/services, without the authorization of BNC, as detailed below.

### **STATEMENT OF CASE**

3. This is a civil action seeking declaratory and injunctive relief, Defendant's profits, damages sustained by Plaintiff, treble damages, statutory damages, and costs of this action, including, without limitation, attorneys' fees, among other relief for: (i) infringement of federally registered trademarks in violation of § 32 of the Federal Trademark Act of 1946, also known as the Lanham Act, codified at 15 U.S.C. § 1114, *et seq.*; (ii) false designation of origin and unfair competition in violation of § 43(a) of the Lanham Act, codified as 15 U.S.C. § 1125(a), *et seq.*; (iii) federal dilution in violation of § 43(c) of the Lanham Act, codified at 15 U.S.C. § 1125 (c); and (iv) unfair competition and unfair trade practices in violation of common law.

4. BNC brings this action due to, among other things, Defendant's willful disregard for BNC's federally- registered and famous **BENIHANA®** Trademarks and Defendant's use of the mark BENNY HUNNA, a mark that is confusingly similar to and dilutive of BNC's **BENIHANA®** Trademarks, in connection with Defendant's advertising and promotion of

entertainment services in the nature of live musical performances and the distribution of musical recordings. Additionally, Defendant's use of BENNY HUNNA, is diluting and is likely to continue to dilute the distinctive quality of the BENIHANA® Trademarks and create consumer confusion and a false association and/or affiliation between BNC and Defendant, when such association or affiliation does not exist.

5. As set forth below, Defendant's acts constitute federal trademark infringement, federal and common law unfair competition, and federal dilution, all in violation of 15 U.S.C. §§ 1114 and 1125(a) and 1125(c).

#### **JURISDICTION AND VENUE**

6. This action arises under the Lanham Act, 15 U.S.C. §§ 1114, 1125(a) and 1125(c), and Mississippi common law.

7. This Court has subject matter jurisdiction over Plaintiff's claims against Defendant pursuant to 28 U.S.C. §§ 1331 and 1338(a) and (b), and 15 U.S.C. § 1121 because this action arises under the Lanham Act. This Court has supplemental subject matter jurisdiction over Plaintiff's state law claims under 28 U.S.C. § 1367(a).

8. Upon information and belief, this Court has personal jurisdiction over Defendant because Defendant has substantial contacts with, and does business in, the State of Mississippi and in this District. Among other things, upon information and belief, Defendant maintains a place of residence and/or business at 122 Country Club Drive, Greenwood, Mississippi 38930. Additionally, upon information and belief, Defendant purposefully avails itself of the benefits and protections of Mississippi law by regularly conducting business in this State and District. Lastly, upon information and belief, this Court also has personal jurisdiction over Defendant

because Defendant has committed willful acts in this State and District that are the subjects of the claims set forth herein.



9. Venue is proper in this District pursuant to 28 U.S.C. § 1391 (b) and (c) because, upon information and belief, Defendant resides in this District and because, upon information and belief, a substantial part of the events giving rise for the claims alleged herein occurred in this District.

### **FACTS COMMON TO ALL COUNTS**


#### ***THE INCONTESTABLE BENIHANA® TRADEMARKS***

10. BNC is the exclusive licensee, with rights of enforcement, of trademarks and service marks consisting of and comprised of the word “BENIHANA” to advertise, promote, offer to sell, and sell its restaurant and related products and services (individually and collectively, the **BENIHANA®** Trademarks”).

11. BNC is the franchisor of United States trademark registrations for the **BENIHANA®** Trademarks, including, without limitation, those identified below:

<b><u>TRADEMARK</u></b>	<b><u>REGISTRATION</u></b>	<b><u>GOODS/SERVICES</u></b>
<b>BENIHANA</b>	US 1,230,609	Restaurant services.
<b>BENIHANA</b>	US 1,371,624	Sake.
<b>BENIHANA</b>	US 1,412,570	Wines, namely, plum wine; and spirits, namely, sake.
	US 2,029,115	Edible oils and fats.
	US 2,119,770	Restaurant services.



	US 2,058,184	Restaurant services.
<b>BENIHANA</b>	US 3,784,161	Drinking mugs.
<b>BENIHANA</b>	US 3,928,737	Franchise services, namely, offering business management assistance in the establishment and operation of restaurant and bar services.

True and correct copies of the above listed trademark registrations are attached as

**Exhibit 1.**

12. Each of the above **BENIHANA®** Registrations is valid, subsisting, and in full force and effect and therefore, confers a nationwide right of exclusive use of the **BENIHANA®** Trademarks in connection with the goods/services applied for in the registrations pursuant to 15 U.S.C. § 1057(c).

13. In fact, all of the **BENIHANA®** Registrations are incontestable and thereby constitute conclusive evidence of BNC's exclusive right to use the marks for the goods/services recited in the registrations, in accordance with 15 U.S.C. § 1065. In addition, the registrations are proof of the inherent distinctiveness of the **BENIHANA®** Trademarks.

14. The **BENIHANA®** Trademarks have been used in interstate commerce and promoted extensively for more than fifty (50) years around the world, with BNC having invested millions of dollars in advertising since the inception of these marks in as early as 1964. BNC advertises, promotes, and markets its **BENIHANA®** products and services on its website located at [www.benihana.com](http://www.benihana.com) and is the owner of hundreds of domain name registrations incorporating, in whole or in part, the **BENIHANA®** Trademarks.

15. BNC has extensively used and continuously promoted the **BENIHANA®** Trademarks both in the United States and abroad, and the marks have thereby become famous and distinctive symbols of BNC's products and services, entitling the **BENIHANA®** Trademarks to protection against dilution by blurring or tarnishment.

16. The **BENIHANA®** Trademarks have become instantly recognizable and famous. The goodwill and reputation of the **BENIHANA®** Trademarks are strong and extremely valuable to BNC.

### ***HISTORY OF THE PARTIES***

17. On or about June 21, 2013, Defendant contacted BNC (and/or its affiliates) via email advising BNC of the filing of its trademark application for the mark BENNY HUNNA, and inquiring as to whether BNC would be interested in sponsoring Defendant in connection with his entertainment services in view of the fact that BNC's BENIHANA trademark was so similar to the mark BENNY HUNNA. A copy of Defendant's June 21, 2013 email correspondence is attached as **Exhibit 2**. In other words, Defendant admitted to the confusingly similarity between the marks, admitted knowing of the **BENIHANA®** Trademarks and approached BNC about doing business together.

18. On December 3, 2013, BNC directed a letter to Defendant and advised Defendant of its **BENIHANA®** Registrations, the **BENIHANA®** Trademarks, and BNC's substantial investment and goodwill in the **BENIHANA®** Trademarks, among other things. A copy of the December 3, 2013 letter is attached as **Exhibit 3**. Based upon its prior-existing and longstanding rights, BNC requested that Defendant cease and desist all use of the **BENIHANA®** Trademarks including, in connection with Defendant's advertising, promotion, and distribution of Defendant's musical recordings.

19. Due to Defendant's failure to cease use of the mark BENNY HUNNA, BNC's sister company, Noodle Time, Inc., filed an Opposition with the Trademark Trial and Appeal Board (TTAB) on January 27, 2014, which proceeding is assigned Proceeding No. 91214649.<sup>2</sup>

20. Given Defendant's failure to produce pertinent information and Defendant's non-responsiveness, BNC had no choice but to proceed with the filing of the instant suit.

***DEFENDANT'S VIOLATION OF THE BENIHANA® TRADEMARKS***

21. Upon information and belief and in blatant disregard of BNC's trademark rights, Defendant has adopted and used the name BENNY HUNNA to promote his musical recordings online via You Tube, among other websites.

22. Defendant also uses social media to promote his musical recordings under the name BENNY HUNNA. For example, Defendant has a Facebook page under the name BENNY HUNNA (<http://facebook.com/benny.hunna1>) wherein he promotes and posts his musical recordings.

23. In fact, Defendant expanded his use of the mark BENNY HUNNA to promote HUNNA TV, an online television show for independent musical artists. Defendant has allegedly directed, produced, and/or appeared in or allegedly directs, produces and/or appears in online episodes under the name BENNY HUNNA. Said episodes are posted online via Facebook at [www.facebook.com/HunnaTv](http://www.facebook.com/HunnaTv) and Defendant's Facebook page referenced above, and YouTube, among other websites.

24. Defendant also filed a trademark application with the United States Patent and Trademark Office on May 2, 2013 for the mark BENNY HUNNA in connection with

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<sup>2</sup> Proceeding No. 91214649 is in the discovery phase. BNC's sister company, Noodle Time, Inc. shall forthwith file a Motion to Stay the Opposition Proceeding pending the outcome of this civil action.

“entertainment services in the nature of live musical recordings.” This application, Serial No. 85/920,599, was published in the Official Gazette on October 8, 2013.

25. Notwithstanding repeated notice of BNC’s rights in and to the **BENIHANA®** Trademarks, among other things, and Defendant’s prior representations to cease use of same, as detailed above, Defendant has continued to use without authorization the **BENIHANA®** Trademarks in blatant disregard of BNC’s rights.

26. Defendant’s use of the mark **BENNY HUNNA** in connection with the promotion and commercial distribution of Defendant’s musical recordings creates confusion and deception among the consuming public.

27. Moreover, Defendant’s use of the **BENIHANA®** Trademarks, and variations thereof, creates a false impression as to an affiliation between the parties where there is not one. Defendant is unfairly trading on the valuable goodwill embodied in the **BENIHANA®** Trademarks.

28. Defendant undertook these activities with full knowledge of the fame and popularity of the **BENIHANA®** Trademark thereby diluting and likely to continue to dilute the distinctive quality of the **BENIHANA®** Trademarks.

**COUNT 1: FEDERAL TRADEMARK INFRINGEMENT**  
**(15 U.S.C. §1114)**

29. Plaintiff hereby incorporates the allegations contained in Paragraphs 1 through 28 as if fully set forth herein.

30. Plaintiff’s use and registration of the **BENIHANA®** Trademarks in the United States for restaurant, bar, and related services predates Defendant’s actions herein.

31. Plaintiff has continuously, extensively, and exclusively used the **BENIHANA®** Trademarks for over forty (40) years and has not abandoned the marks.

32. Plaintiff's **BENIHANA®** Trademarks are incontestable.

33. Defendant's use of the mark **BENNY HUNNA** is likely to cause confusion, to cause mistake, or to deceive persons into the erroneous belief that the services promoted by Defendants are authorized, sponsored by, or connected in some way with Plaintiff, all in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

34. Defendant's use of the **BENIHANA®** Trademarks is without Plaintiff's consent.

35. Upon information and belief, the aforementioned acts and conduct of Defendant was carried out with full knowledge of and after the registration of the **BENIHANA®** Trademarks. As such, Defendant's use of the **BENIHANA®** Trademarks renders Defendant's trademark infringement willful.

36. As a direct and proximate result of Defendant's conduct, Plaintiff has suffered irreparable harm to its reputation and goodwill and will continue to be irreparably damaged by the use of the **BENIHANA®** Trademarks in that consumers are likely to be confused or deceived that Defendant's activities are authorized, endorsed, sponsored, or otherwise approved by Plaintiff.

37. Unless Defendant is enjoined and restrained from its continued use of the **BENIHANA®** Trademarks, Plaintiff will continue to suffer immediate, substantial and irreparable harm that cannot be adequately calculated and compensated in whole by monetary damages.

38. By reason of Defendant's wrongful acts, Plaintiff has been injured in an amount to be determined at trial and is entitled to the remedies provided for in 15 U.S.C. §§ 1116 and 1117, *et seq.*

**COUNT 2: FEDERAL UNFAIR COMPETITION**  
**(15 U.S.C. § 1125(a))**

39. Plaintiff incorporates the allegations contained in Paragraphs 1 through 38 as if fully set forth herein.

40. Defendant's unauthorized use of the mark **BENNY HUNNA** unfairly competes with Plaintiff and constitutes a false designation of origin and false description and falsely represents to the public that the goods/services advertised, sold, or offered for sale by Defendant emanate from the same source or origin of BNC's goods/services, or that BNC authorizes, endorses, sponsors, or otherwise approves Defendant's goods/services, when BNC does not.

41. Defendant, with knowledge of such falsity, offered or caused to be offered, advertised, and sold goods/services in connection with trademarks and symbols that are confusingly similar to the **BENIHANA®** Trademarks.

42. Defendant's use of the **BENIHANA®** Trademarks is without Plaintiff's permission, license, or consent. Defendant is not connected with Plaintiff or the **BENIHANA®** Trademarks. Plaintiff has repeatedly objected to Defendant's use and Defendant has intentionally ignored such demands, intending to trade on the goodwill associated with the **BENIHANA®** Trademarks.

43. Defendant's acts constitute unfair competition with Plaintiff in violation of 15 U.S.C. § 1125(a).

44. Unless Defendant is enjoined and restrained from its continued use of the **BENIHANA®** Trademarks, Plaintiff will continue to suffer immediate, substantial and irreparable harm that cannot be adequately calculated and compensated in whole by monetary damages.

45. By reason of Defendant's wrongful acts, Plaintiff has been injured in an amount to be determined at trial and is entitled to the remedies provided for in 15 U.S.C. §§ 1116 and 1117, *et seq.*

**COUNT 3: FEDERAL TRADEMARK DILUTION**  
**15 U.S.C. § 1125(c)**

46. Plaintiff incorporates the allegations contained in Paragraphs 1 through 45 as if fully set forth herein.

47. Plaintiff continues to use the **BENIHANA®** Trademarks in interstate commerce. The **BENIHANA** Trademark is famous and distinctive in the United States as that term is defined in Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Plaintiff has taken reasonable steps to preserve the integrity and image of the **BENIHANA®** Trademark.

48. Defendant began using the BENNY HUNNA designation long after the **BENIHANA®** Trademark became famous.

49. Defendant's intentional, commercial use of the designation BENNY HUNNA is likely causing and will continue to likely cause dilution of the distinctive quality of Plaintiff's famous **BENIHANA®** Trademark.

50. Upon information and belief, Defendant's commercial use of the designation BENNY HUNNA in its promotion and distribution of Defendant's musical recordings demonstrates Defendant's willful intent to trade on Plaintiff's reputation and to cause dilution of Plaintiff's **BENIHANA®** Trademark.

51. As a direct and proximate result of Defendant's conduct, Plaintiff has suffered irreparable harm to its reputation and goodwill and continues to suffer irreparable injury to Plaintiff's business by dilution of the distinctive quality of the **BENIHANA®** Trademark, in violation of 15 U.S.C. 1125(c), for which Plaintiff has no adequate remedy at law.

52. Unless Defendant is enjoined and restrained from its continued use and promotion of the designation BENNY HUNNA, Plaintiff will continue to suffer immediate, substantial and irreparable harm that cannot be adequately calculated and compensated in whole by monetary damages.

53. By reason of Defendant's wrongful acts, Plaintiff has been injured in an amount to be determined at trial and is entitled to the remedies provided for in 15 U.S.C. §§ 1116 and 1117, *et seq.*

**COUNT 4: COMMON LAW UNFAIR COMPETITION  
AND UNFAIR TRADE PRACTICES**

54. Plaintiff incorporates the allegations contained in Paragraphs 1 through 53 as if fully set forth herein.

55. This is a claim for common law unfair competition and unfair trade practices arising under the common law of the State of Mississippi.

56. Defendant's unauthorized use of the **BENIHANA®** Trademarks in his trade names, trademarks and/or corporate names in connection with the sale, offering for sale, distribution, or advertising of goods or services unfairly competes with BNC, constitutes a false designation of origin and false description, and falsely represents to the public that the goods/services advertised, sold, or offered for sale by Defendant (and/or his affiliates or business partners) emanate from the same source or origin as BNC's goods/services, or that BNC authorizes, endorses, sponsors, or otherwise approves those goods/services, when BNC does not.

57. Defendant, with knowledge of such falsity, directly and/or indirectly, offered or caused to be offered, advertised, and sold goods/services in connection with trademarks and trade names that are confusingly similar to the **BENIHANA®** Trademarks.



58. Defendant's use and filing of a trademark application for the mark BENNY HUNNA are all without BNC's permission, license, or consent. Defendant is not connected with BNC or the **BENIHANA®** Trademarks. BNC has objected to Defendant's use and attempted registration of the mark BENNY HUNNA and Defendant has intentionally ignored such demands and has continued to use the mark BENNY HUNNA, intending to trade on the goodwill associated with the **BENIHANA®** Trademarks.

59. Defendant's actions constitute common law unfair competition and unfair trade practices in violation of the common law of Mississippi.

60. Upon information and belief, Defendant's aforementioned unfair competition and unfair trade practices were carried out willfully, wantonly, and maliciously with the intent and purpose of appropriating and trading upon the goodwill and reputation of BNC and the **BENIHANA®** Trademarks and to pass off Defendant's goods/services as BNC's goods/services, or as having been sponsored or approved by BNC or at least in reckless disregard of the property rights of BNC entitling BNC to punitive or exemplary damages.

61. BNC has been and will continue to be irreparably injured by Defendant's conduct. BNC cannot be adequately compensated for these injuries by monetary remedies alone, and BNC has no adequate remedy at law for Defendant's unfair competition and unfair trade practices. BNC is therefore entitled to injunctive relief against Defendant, and, after trial, to recover any damages proven to have been caused, or any profits of Defendant that have been earned unjustly, by reason of Defendant's acts of infringement and unfair competition along with punitive or exemplary damages.

**DEMAND FOR JURY TRIAL**

Plaintiff respectfully demands a trial by jury in this action of all issues so triable.

**PRAYER FOR RELIEF**

WHEREFORE, Plaintiff Benihana National Corp. respectfully prays for the following relief against Defendant:

- (a) An order declaring that Defendant's unauthorized conduct violates the Lanham Act, 15 U.S.C. §§ 1114, 1125(a), and 1125(c), and Mississippi common law;
- (b) An order permanently enjoining and restraining Defendant and those in active concert and participation with Defendant from:
  - 1. Further infringing and/or making any use of the **BENIHANA®** Trademarks, or any mark confusingly similar thereto to advertise, promote, display or sell any good/service;
  - 2. Representing or suggesting to any third party that Defendant is affiliated with, sponsored by, licensed by, or otherwise connected with BNC or the **BENIHANA®** Trademarks; and
  - 3. Otherwise unfairly competing with BNC;
- (c) An order compelling Defendant to remove all signs, and to recall all copies of print media, press releases, promotions, or advertisements in Defendant's control bearing the **BENIHANA®** Trademarks, and all related goods/services and/or materials, pursuant to 15 U.S.C. § 1118;
- (d) An order directing any other relief that the Court may deem appropriate to prevent the public from deriving any erroneous impression that any goods/services offered by Defendant are authorized by BNC or are in any way related to BNC and BNC's goods/services; and
- (e) An order directing an accounting and judgment be rendered against Defendant for:
  - 1. An award of profits received by Defendant from its misuse of the **BENIHANA®** Trademarks, as provided for in 15 U.S.C. § 1117;
  - 2. All profits received by Defendant and all damages sustained by BNC on account of Defendant's false suggestion or connection with BNC through the use of the **BENIHANA®** Trademarks;
  - 3. An award of damages to BNC for Defendant's wrongful conduct, including treble damages for Defendant's intentional and willful conduct pursuant to 15 U.S.C. § 1117;

4. An award to BNC for costs, including reasonably attorneys' fees and disbursements in this action, pursuant to 15 U.S.C. § 1114; and
5. Any other relief that the Court finds warranted and just.

/s/ Brett A. Schubert

(MS Bar No. 102005)

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*Attorneys for Plaintiffs*

*Benihana National Corp.*

# **EXHIBIT 1**

Int. Cl.: 42

Prior U.S. Cl.: 100

**United States Patent and Trademark Office**

**Reg. No. 1,230,609**  
Registered Mar. 8, 1983

**SERVICE MARK**  
Principal Register

**BENIHANA**

Benihana of Tokyo, Inc. (New York corporation)  
8685 NW. 53rd Ter.  
Miami, Fla. 33166

For: RESTAURANT SERVICES, in CLASS 42  
(U.S. Cl. 100).

First use 1968; in commerce 1968.

Owner of U.S. Reg. Nos. 940,142, 1,023,463 and  
others.

The word "Benihana" is translated as "red  
flower".

Ser. No. 359,594, filed Apr. 13, 1982.

G. MAYERSCHOFF, Examining Attorney

Int. Cl.: 33

Prior U.S. Cl.: 48

Reg. No. 1,371,624

**United States Patent and Trademark Office** Registered Nov. 19, 1985

**TRADEMARK  
PRINCIPAL REGISTER**

**BENIHANA**

BENIHANA OF TOKYO, INC. (NEW YORK CORPORATION)  
8685 N. W. 53RD TERRACE  
MIAMI, MI 33166, ASSIGNEE OF NUMANO SAKE COMPANY, INC. (CALIFORNIA CORPORATION), DBA NUMANO SAKE CO. AND NUMANO SAKE COMPANY, BERKELEY, CA 94710

FOR: SAKE, IN CLASS 33 (U.S. CL. 48).  
FIRST USE 3-0-1980; IN COMMERCE 3-0-1980.

THE ENGLISH TRANSLATION OF THE WORD "BENIHANA" IS "RED FLOWER".

SER. NO. 405,598, FILED 12-10-1982.

ELLEN M. DEVINE, EXAMINING ATTORNEY

Int. Cl.: 33

Prior U.S. Cls.: 47 and 48

**United States Patent and Trademark Office**

**Reg. No. 1,412,570**

Registered Oct. 7, 1986

**TRADEMARK  
PRINCIPAL REGISTER**

**BENIHANA**

BENIHANA OF TOKYO, INC. (NEW YORK  
CORPORATION)  
8685 N.W. 53RD TERRACE  
MIAMI, FL 33152

FOR: WINES, NAMELY, PLUM WINE; AND  
SPIRITS, NAMELY, SAKE, IN CLASS 33 (U.S.  
CLS. 47 AND 48).

FIRST USE 12-31-1985; IN COMMERCE  
12-31-1985.

OWNER OF U.S. REG. NOS. 940,142, 1,371,624  
AND OTHERS.

THE ENGLISH TRANSLATION OF THE  
WORD "BENIHANA" IN THE MARK IS "RED  
FLOWER".

SER. NO. 586,169, FILED 3-5-1986.

AMANDA LAURA NYE, EXAMINING ATTOR-  
NEY

Int. Cl.: 29

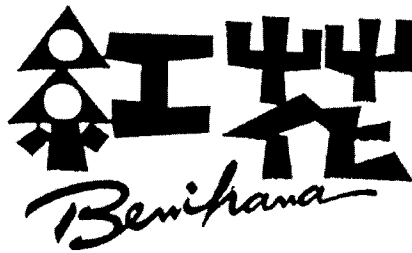
Prior U.S. Cl.: 46

Reg. No. 2,029,115

**United States Patent and Trademark Office**

Registered Jan. 7, 1997

**TRADEMARK  
PRINCIPAL REGISTER**



BENIHANA NATIONAL CORP. (DELAWARE CORPORATION)  
8685 N.W. 53RD TERRACE  
MIAMI, FL 33166 ASSIGNEE OF BENIHANA  
OF TOKYO, INC. (NEW YORK CORPORATION) MIAMI, FL 331664591

FOR: EDIBLE OILS AND FATS, IN CLASS 29  
(U.S. CL. 46).

FIRST USE 8-5-1996; IN COMMERCE  
8-5-1996.

OWNER OF U.S. REG. NOS. 940,142, 1,023,463,  
AND OTHERS.

THE NON-LATIN CHARACTERS IN THE  
MARK transliterate to "BENI HANA",  
AND THIS MEANS "RED FLOWER" IN ENGLISH.  
THE MARK "BENIHANA" IS TRANSLATED AS RED FLOWER.

SN 74-521,919, FILED 4-29-1994.

EVERETT FRUEHLING, EXAMINING ATTORNEY



Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

Reg. No. 2,058,184

**United States Patent and Trademark Office**

Registered Apr. 29, 1997

**SERVICE MARK  
PRINCIPAL REGISTER**



BENIHANA NATIONAL CORP. (DELAWARE  
CORPORATION)  
8685 N.W. 53RD TERRACE  
MIAMI, FL 33166

OWNER OF U.S. REG. NOS. 937,781, 1,230,609,  
AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "GRILL", APART FROM THE  
MARK AS SHOWN.

FOR: RESTAURANT SERVICES, IN CLASS  
42 (U.S. CLS. 100 AND 101).

SN 74-702,907, FILED 7-18-1995.

FIRST USE 12-0-1995; IN COMMERCE  
12-0-1995.

WILLIAM P. SHANAHAN, EXAMINING AT-  
TORNEY

**Int. Cl.: 5**

**Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52**

**Reg. No. 2,110,770**

**United States Patent and Trademark Office**

**Registered Nov. 4, 1997**

**TRADEMARK  
PRINCIPAL REGISTER**

**BLAST B-12**

GEORGIA BARIATRICS, P.C. (GEORGIA COR-  
PORATION)  
2904 MACON ROAD  
COLUMBUS, GA 31906

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "B-12", APART FROM THE  
MARK AS SHOWN.

FOR: VITAMIN PREPARATIONS, IN CLASS  
5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).  
FIRST USE 4-2-1995; IN COMMERCE  
4-2-1995.

SER. NO. 75-196,597, FILED 11-12-1996.

JOHN DALIER, EXAMINING ATTORNEY

# United States of America

United States Patent and Trademark Office

## BENIHANA

**Reg. No. 3,784,161**

**Registered May 4, 2010**

**Int. Cl.: 21**

**TRADEMARK**

**PRINCIPAL REGISTER**

NOODLE TIME, INC. (FLORIDA CORPORATION)  
8685 N.W. 53RD TERRACE  
MIAMI, FL 33166

FOR: DRINKING MUGS, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 12-31-1980; IN COMMERCE 12-31-1980.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,230,609, 1,412,570 AND OTHERS.

THE ENGLISH TRANSLATION OF "BENIHANA" IN THE MARK IS "RED FLOWER".

SER. NO. 77-829,100, FILED 9-17-2009.

JENNY PARK, EXAMINING ATTORNEY



*David J. Kyros*

Director of the United States Patent and Trademark Office

# United States of America

United States Patent and Trademark Office

## BENIHANA

**Reg. No. 3,928,737**

**Registered Mar. 8, 2011**

**Int. Cl.: 35**

**SERVICE MARK**

**PRINCIPAL REGISTER**

NOODLE TIME, INC. (FLORIDA CORPORATION)  
SUITE 201  
8685 NW 53RD TERRACE  
MIAMI, FL 33166

FOR: FRANCHISE SERVICES, NAMELY, OFFERING BUSINESS MANAGEMENT ASSISTANCE IN THE ESTABLISHMENT AND OPERATION OF RESTAURANT AND BAR SERVICES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 0-0-1971; IN COMMERCE 0-0-1971.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,230,609, 1,412,570 AND OTHERS.

THE ENGLISH TRANSLATION OF "BENIHANA" IS "RED FLOWER".

SER. NO. 85-124,979, FILED 9-8-2010.

MELISSA VALLILLO, EXAMINING ATTORNEY



*David J. Kybas*

Director of the United States Patent and Trademark Office

# EXHIBIT 2

**From:** [do\\_not\\_reply@benihana.com](mailto:do_not_reply@benihana.com) [[mailto:do\\_not\\_reply@benihana.com](mailto:do_not_reply@benihana.com)]

**Sent:** Friday, June 21, 2013 12:30 PM

**To:** Luisa Ruiz

**Subject:** [bennyhodge25@yahoo.com](mailto:bennyhodge25@yahoo.com)

Submitted on: 06/21/13 - 12:30pm

Submitted values are:

First Name: BENNY

Last Name: HODGE

Address: 122 COUNTRY CLUB DR.

City: GREENWOOD

State: MS

Zip Code 38930

Phone Number: 662-897-8525

Birthday: //

E-Mail Address: [bennyhodge25@yahoo.com](mailto:bennyhodge25@yahoo.com)

Choose Your Category: Marketing

Choose Your Location: Memphis-TN

Comments: MY NAME IS BENNY HODGE. I AM THE SERVICE MARK OWNER THE NAME BENNY HUNNA. BENNY HUNNA IS AN ENTERTAINER/MUSICIAN/DIRECTOR. BY THE NAMES BENIHANA AND BENNY HUNNA BEING SO SIMILAR IN PRONOUNCIATION IT WILL BE A MATTER OF TIME BEFORE WE COME TOGETHER AND BE A HOUSE HOLD NAME "EVERYWHERE". MUSIC IS MY PROFESSION AND I KNOW WE CAN REACH A BROADER AUDIENCE THROUGH MUSIC AND MUSIC VIDEOS. I ATE AT BENIHANA IN MEMPHIS, TENNESSEE FOR MY BIRTHDAY AND REALLY ENJOYED THE HOSPITALITY AND GREAT FOOD (SEAFOOD DIABLO). I WOULD LIKE TO START WITH THE BENIHANA IN MEMPHIS, TENNESSEE AND GO TO EVERYONE IN THE WORLD, AFTER ALL I AM BENNY HUNNA AND IT WOULD ONLY BE RIGHT. WHAT I AM SAYING IS I NEED A SPONSER AND CORPORATE KNOWLEDGE WHICH BENIHANA HAS. I HAVE A NUMBER OF VIDEOS ON THE WEB. THE EASIEST WAY TO ACCESS THEM IS TO GOOGLE SEARCH BENNY HUNNA. AS I STATED I AM THE OWNER OF THE SERVICE MARK (TRADEMARK) BENNY HUNNA AND I KNOW WITH MY MUSICAL TALENT AND BENIHANA'S CORPORATE KNOWLEDGE WE CAN EXPAND BROADER ACROSS THE GLOBE. THANKS FOR YOUR COOPERATION AND I WILL BE LOOKING FORWARD TO HEARING FROM BENIHANA AND EVENTUALLY DOING BUSINESS WITH YOU.

View and reply to this message [here](#).

# **EXHIBIT 3**



# MAVEN

INTELLECTUAL PROPERTY

**Janet C. Moreira, Esq., Lead Maven**  
*Florida Board Certified Intellectual Property Law*

December 3, 2013

**By E-mail: bennyhodge25@yahoo.com**



Benny Hodge  
 122 Country Club Drive  
 Greenwood, Mississippi 38930

Re: Unauthorized Use of Intellectual Property - **BENIHANA®**  
 Our File No. 1000-0001/ BENNY HUNNA

Dear Mr. Hodge:


We represent Benihana National Corp. ("BNC") in connection with its intellectual property matters. BNC is the exclusive licensee, with rights of enforcement, of all right, title and interest in and to the **BENIHANA®** brand, including the **BENIHANA®** Trademarks (defined below) and other intellectual property, relating to the operation of the **BENIHANA®** Restaurants.

BNC has exclusive rights to use the following federally registered trademarks, among others, in the United States ("**BENIHANA®** Trademarks"):

<u>TRADEMARK</u>	<u>REGISTRATION</u>	<u>GOODS/SERVICES</u>
<b>BENIHANA</b>	US 1,230,609	Restaurant services.
<b>BENIHANA</b>	US 1,371,624	Sake.
<b>BENIHANA</b>	US 1,412,570	Wines, namely, plum wine; and spirits, namely, sake.
	US 2,029,115	Edible oils and fats.
	US 2,119,770	Restaurant services.



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	US 2,058,184	Restaurant services.
<b>BENIHANA</b>	US 3,784,161	Drinking mugs.
<b>BENIHANA</b>	US 3,928,737	Franchise services, namely, offering business management assistance in the establishment and operation of restaurant and bar services.

Our client also owns rights to the **BENIHANA®** Trademarks. The **BENIHANA®** brand and **BENIHANA®** Trademarks have been used and promoted extensively for nearly (50) years around the world, with BNC having invested millions of dollars in advertising since the inception of these marks in as early as 1964. BNC advertises, promotes, and markets its **BENIHANA®** products and services on its website located at [www.benihana.com](http://www.benihana.com) and is the owner of hundreds of domain name registrations incorporating, in whole or in part, the **BENIHANA®** Trademarks. The **BENIHANA®** brand and **BENIHANA®** Trademarks have become instantly recognizable and famous. The goodwill and reputation of the **BENIHANA®** brand and **BENIHANA®** Trademarks are strong and extremely valuable to BNC; consequently, BNC takes the protection of its intellectual property rights very seriously.

It has come to our recent attention that you attempted to reach out to our client, and/or one of its affiliates, in June 2013 suggesting that our client consider a business relationship and/or marketing affiliation with you as you were the service mark owner of BENNY HUNNA. A month prior, it appears that you filed a federal intent-to-use application to register BENNY HUNNA in connection with "entertainment services in the nature of live musical performances." Our recent research shows that you use the confusingly similar mark "BENNY HUNNA" to promote and advertise the songs, music videos and a YouTube television series. The advertising and promotion of these items misuses the **BENIHANA®** mark in its entirety for commercial purposes, namely, promoting the commercial sale of the artist BENNY HUNNA however, our client has not authorized or consented to your use of the **BENIHANA®** Trademarks.

The BENNY HUNNA mark is substantially similar to our client's **BENIHANA®** Trademarks, and is designed to capitalize on the distinctive and famous **BENIHANA®** Trademarks and registration without BNC's permission. This misuse may constitute trademark infringement, unfair competition, false advertising, false designation of origin, and dilution, all of which are violations of federal law and state law. The Federal Trademark Act provides numerous remedies for the misuse of a trademark or trade name, trademark, or trade name infringement, and dilution, including but not limited to, preliminary and permanent injunctive relief, money damages, the infringer's profits, an award of attorneys' fees and costs, and up to three times the amount of actual damages.

BNC views this as an extremely serious matter. In fact, we have filed an extension of time to oppose your pending federal application to register BENNY HUNNA, Application Serial No. 85/920,599, and have until February 5, 2014 to file our notice of opposition. Recognizing the high

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cost of litigation however, it is our hope that this matter may be amicably resolved. In order to immediately resolve this dispute, we are willing to settle this matter without pursuing monetary damages, subject to the following terms and conditions:

- (1) You, your company, employees, agents, successors and assigns ("you") will immediately cease and refrain from further registering or attempting to register any domain names, corporate names, trade names, and/or product names that consist of, in whole or in part, the BENNY HUNNA marks, the BENIHANA® Trademarks, and/or any marks confusingly similar thereto; and
- (2) You will immediately take steps to expressly abandon your pending federal trademark application, Serial No. 85/920,599, and will refrain from filing any additional domestic or foreign applications that consist of, in whole or in part, the BENNY HUNNA marks, the BENIHANA® Trademarks, and/or any marks confusingly similar thereto;
- (3) You will immediately cease and refrain from using, creating, marketing, advertising, or distributing any business cards, brochures, advertisements, and/or other business or promotional materials that display any trademarks, trade names, and/or corporate names, consisting of, in whole or in part, the BENNY HUNNA marks, the BENIHANA® Trademarks, and/or any marks confusingly similar thereto;
- (4) By no later than **January 3, 2013**, you will transfer to our client any domain names you own and/or control, including secondary domain names located on social media websites, and consisting of, in whole or in part, the BENNY HUNNA marks, the BENIHANA® Trademarks, and/or any marks confusingly similar thereto; and

You must respond to this letter by no later than **5:00 p.m. EST on Wednesday, December 11, 2013**.

Please understand that this letter and any subsequent discussions do not purport to be a complete statement of the law or fact and are without prejudice to our legal and equitable rights which are expressly reserved.

We await your favorable response. Please govern yourselves accordingly.

Sincerely,

/s/ Janet C. Moreira

Janet C. Moreira, Esq.

Cc: Benihana National Corp.